

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed May 7, 2008. At the time of the Office Action, Claims 6-12 were pending in this Application. Claims 6-12 were rejected. Claims 6 and 8 have been amended. Claims 1-5 were previously canceled. Claims 13-25 have been added. Applicant respectfully requests reconsideration and favorable action in this case.

New independent claim 13 includes the additional limitation that the step of lacwuering is performed without brushing said circuit board. This limitation is disclosed in the originally submitted specification, for example, on page 5, step 4 of the inventive method. Thus no new matter has been introduced.

New independent claim 20 is a combination of amended claim 6 and new claim 13. hence, no new matter has been introduced.

Rejections under 35 U.S.C. § 112

Claim 8 was rejected by the Examiner under 35 U.S.C. §112, second paragraph, as being indefinite and failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant amends Claims 8 to overcome these rejections. Amended claim 8 now recites that the medium used in filling the bores and the insulating lacquer is non-resistant to etching. As stated in the specification, conventional methods require that the filling material must be etch-resistant. See, specification, page 5, paragraph [0020]. According to the specification no such special plugging paste is necessary. See, specification, page 7, paragraph [0032]. Thus, no new matter has been introduced.

Rejections under 35 U.S.C. § 102

Claims 6 and 8 were rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 6,407,345 Naohiro Hirose et al. ("*Hirose*"). Applicant respectfully traverses and submit the cited art does not teach all of the elements of the claimed embodiment of the invention.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, “the identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicant respectfully submits that the art cited as anticipatory by the Examiner cannot anticipate the rejected Claims, because the cited art does not show all the elements of the present Claims.

According to the amended independent claim 6, the method includes that besides the claimed layers no additional layer is introduced on the surface of the circuit board between the steps of etching and applying an insulating layer. However, *Hirose* discloses a plurality of additional steps that are required which introduce additional layers to the printed circuit board. For example, in step (D) and (G) *Hirose* teaches to apply a coarsened layer 38 and 42. *Hirose*, col. 15, lines 15-21 and lines 45-51. Hence, Applicant believes that the amended claims are not anticipated by *Hirose*.

Rejections under 35 U.S.C. §103

Claims 6-12 were rejected under 35 U.S.C. §103(a) as being unpatentable over Applicant’s admitted prior art (“APA”) in view of *Hirose*. Applicant respectfully traverses and submit the cited art combinations, even if proper, which Applicant does not concede, does not render the claimed embodiment of the invention obvious.

In order to establish a prima facie case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Even if each limitation is disclosed in a combination of references, however, a claim composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int’l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Rather, the Examiner must identify an apparent reason to combine the known elements in the fashion claimed. *Id.* “Rejections on

obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Finally, the reason must be free of the distortion caused by hindsight bias and may not rely on ex post reasoning. *KSR*, 127 S.Ct. at 1742. In addition, evidence that such a combination was uniquely challenging or difficult tends to show that a claim was not obvious. *Leapfrog Enterprises, Inc. v. Fisher-Price, Inc. and Mattel, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007), citing *KSR*, 127 S.Ct. at 1741.

As stated above, Applicant amended the independent claim 6 to include the limitation that between the steps of etching and applying an insulating lacquer no further layers are applied to said circuit boards. As stated above, *Hirose* clearly teaches away from this limitation because *Hirose* requires the application of additional coarsened layers 38 and 42.

Moreover, the admitted prior art requires a different step sequence. Hence it is unclear how a person skilled in the art would combine the admitted prior art with *Hirose*.

Hence, Applicant believes that the independent claim 6 is not rendered obvious. Applicants respectfully submit that the dependent Claims are allowable at least to the extent of the independent Claim to which they refer, respectively. Thus, Applicants respectfully request reconsideration and allowance of the dependent Claims. Applicants reserve the right to make further arguments regarding the Examiner's rejections under 35 U.S.C. §103(a), if necessary, and do not concede that the Examiner's proposed combinations are proper.

Association of Customer Number and Change of Correspondence Address

Applicant respectfully requests that all papers pertaining to the above-captioned patent application be associated with Customer No. **31625**, and direct all correspondence pertaining to this patent application to practitioners at Customer Number **31625**. All telephone calls should be directed to Andreas Grubert at 512.322.2545. A Revocation and Power of Attorney will be submitted shortly.

CONCLUSION

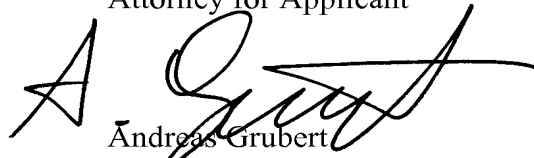
Applicant has now made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicant respectfully requests reconsideration of Claims 6 and 8 as amended.

Applicant respectfully submit a Request for Continued Examination (RCE) Transmittal. The Commissioner is authorized to charge the amount of \$810.00 to Deposit Account 50-2148 in order to effectuate this filing.

Applicant believes there are no additional fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicant's attorney at 512.322.2545.

Respectfully submitted,
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Date: August 6, 2008

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